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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,190	04/19/2001	Steven Russell Day		1515

7590 05/11/2004

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EXAMINER

VANAMAN, FRANK BENNETT

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	R
	09/839,190	DAY ET AL.	
	Examiner	Art Unit	
	Frank Vanaman	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 February 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,8-11 and 14-18 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-6,8-11 and 14-18 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Status of Application

1. Applicant's amendment, filed on Feb. 17, 2004 has been entered in the application. Claims 1-6, 8-11, 14-18 remain pending.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 8, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodriguez (US 2,200,935, cited previously). Rodriguez '935 teaches a skateboard having an elongated deck (10), a plate (11') with a perimeter including sides and ends, and having a top surface directly abutting a lower surface of the deck (10), the plate having the resilient properties of the material from which it is made, and having the hardness of the material from which it is made, the plate perimeter being located within the deck perimeter, the lower surface extending continuously throughout the plate, and not protruding beyond a given thickness (note figures 1 and 3), or including any protruding elements; first and second trucks (14) located at opposing deck ends, and having respective pairs of wheels (16, 17), and connected to the deck (10) through fasteners such as bolts or screws (15), which pass through apertures in the plate (not referenced) in order to mount to the deck (10), wherein the plate is attached to the deck between the deck and mounting faces (18) of the trucks, the mounting faces of the trucks having a width of same dimension as the plate width (note also figure 2), the plate having a front extent which is flush with the front-most edge of the front truck mounting face, the capable of allowing sliding on a surface oriented with respect to the plate.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 2-6, 9-11, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez (US 2,200,935). As regards claims 2, 10, and 16, the reference of Rodriguez '935 fails to teach the plate as being made of a resilient plastic material. Resilient plastics are very well known in the manufacturing arts, and as such, it

would have been obvious to one of ordinary skill in the art at the time of the invention to make the plate of Rodriguez '935 from a plastic such as a polycarbonate, for the purpose of providing a plate which is both light weight and has a high impact strength, thus improving the life-span of the plate under use.

As regards claims 3, 11, 17 and 18, the reference of Rodriguez '935 fails to teach a specific thickness for the plate, however it is well known to adjust the thickness of structural members of a designed mechanism to meet a specific requirement, such as a height, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to adjust the thickness of the plate of Rodriguez '935 to between 0.1 and 0.33, or more specifically 0.25 inches, for the purpose of optimizing the height which is added to the skateboard by the use of the plate.

As regards claims 6, 9, and 15, the reference to Rodriguez '935 fails to teach the length as being equivalent to the span between the ends of the mounting bases (the front extents being flush, but the rear extents having an overhang), however it is well known to decrease the size of manufactured elements for the purposes of using lesser quantities of material (thus saving costs), and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to size the plate of Rodriguez '935 to be equal to the distal end span of the mounting bases of the wheel trucks for the purpose of achieving an incremental reduction in cost of manufacturing the board.

Response to Arguments

6. Applicant's comments have been carefully considered. As regards the claim rejections previously set forth under 35 USC §112, second paragraph, applicant's clarification of the definition which applicant desires to apply to the term "unobtrusive sliding surface" is noted, and the rejection is withdrawn, with applicant's definition as set forth in the response being applied in the interpretation of the term. Applicant's comments, directed to the reference of Rodriguez, concerning wood, and how the material is well known in the art to have an 'inconsistent' surface structure are confusing. There is no teaching in the reference to Rodriguez that the wood surface has any inconsistencies in it, and in fact, none are illustrated in the reference. As such, to the degree claimed, the structure taught by Rodriguez constitutes a consistent surface.

Additionally, it is not at all clear what particular types or forms of inconsistencies applicant is referring to. Similarly, the surface taught by the wood portion of Rodriguez appears continuous to the breadth claimed, in that there are no discontinuities shown in the figures or discussed in the specification. Applicant appears to be arguing against elements of Rodriguez which are not actually illustrated in the reference, but has presented no evidence to support these allegations. Please note that the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). As regards the functional limitations which applicant alleges define beyond the reference to Rodriguez, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the reference to Rodriguez can perform the functional recitations to the breadth these limitations are actually claimed.

As regards applicant's arguments that there is no reason to substitute a different material for the wood element taught by Rodriguez, applicant is reminded that Rodriguez positively anticipates that a material other than wood may be used (see page 1, col. 2, lines 2-5), and in view of the well known advantages of plastics, it is not deemed beyond the skill of the ordinary practitioner to employ a plastic as set forth above. Applicant's comments concerning the plastics claimed as being "significantly less rigid and more dense than wood" are noted, however the particular wood used by Rodriguez is not specified, and it is not entirely clear how applicant may make such a comparison given the nature of the teachings of Rodriguez. Further applicant's assertions concerning the particular use of the wood element taught by Rodriguez are unclear, given the teachings of Rodriguez as to the use of the wood element.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 703-308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-1113.

As of May 1, 2003, any response to this action should be mailed to:

Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450,
Or faxed to one of the following fax servers:
Regular Communications/Amendments: 703-872-9326
After Final Amendments: 703-872-9327
Customer Service Communications: 703-872-9325

F. VANAMAN
Primary Examiner
Art Unit 3618

A handwritten signature in black ink, appearing to read "F. VANAMAN" above "Art Unit 3618". To the right of the typed name is a handwritten signature, which appears to be "F. VANAMAN" followed by "Art Unit 3618" and a date like "5/5/04".